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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/424,458	03/16/2000	NICHOLAS HAYWARD	13198	8014

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EXAMINER

LEFFERS JR, GERALD G

ART UNIT	PAPER NUMBER
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1636

DATE MAILED: 01/28/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/424,458

Applicant(s)

HAYWARD ET AL.

Examiner

Gerald Leffers

Art Unit

1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-24 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: *301a 101a*

Art Unit: 1636

DETAILED ACTION

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions that are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-3, 8-10, 15-16, drawn to an isolated nucleic acid encoding a regulator of gene expression, MCG4 (SEQ ID NOS: 2-3), and to a method of detecting a condition caused by an aberration in *mcg4* due to nucleotide alterations in the coding sequence.

Group II, claim(s) 1-2, 4-5, 8, 11-12, 15 and 19, drawn to an isolated nucleic acid encoding a regulator of gene expression, MCG7 (SEQ ID NOS: 4-5), and to a method of detecting a condition caused by an aberration in *mcg7* due to nucleotide alterations in the coding sequence.

Group III, claim(s) 1-2, 4-5, 8, 11-12, 15 and 19, drawn to an isolated nucleic acid encoding a regulator of gene expression, MCG7 (SEQ ID NOS: 6-7), and to a method of detecting a condition caused by an aberration in *mcg7* due to nucleotide alterations in the coding sequence.

Group IV, claim(s) 1-2, 6-8, 13-15 and 22, drawn to an isolated nucleic acid encoding a regulator of gene expression, MCG18 (SEQ ID NOS: 8-9), and to a method of detecting a condition caused by an aberration in *mcg18* due to nucleotide alterations in the coding sequence.

Group V, claim(s) 17, drawn to a method of detecting a condition associated with an aberration in *mcg4* wherein a change in the amino acid sequence of MCG4 is detected (SEQ ID NO: 3).

Group VI, claim(s) 18, drawn to a method of detecting MCG4 with an antibody directed against the protein (SEQ ID NO: 3).

Group VII, claim(s) 20, drawn to a method of detecting a condition associated with an aberration in *mcg7* wherein a change in the amino acid sequence of MCG7 is detected (SEQ ID NO: 5).

Art Unit: 1636

Group VIII, claim(s) 21, drawn to a method of detecting MCG7 with an antibody directed against the protein (SEQ ID NO: 5).

Group IX, claim(s) 20, drawn to a method of detecting a condition associated with an aberration in *mcg7* wherein a change in the amino acid sequence of MCG7 is detected (SEQ ID NO: 7).

Group X, claim(s) 21, drawn to a method of detecting MCG7 with an antibody directed against the protein (SEQ ID NO: 7).

Group XI, claim(s) 23, drawn to a method of detecting a condition associated with an aberration in *mcg18* wherein a change in the amino acid sequence of MCG18 is detected (SEQ ID NO: 9).

Group XII, claim(s) 24, drawn to drawn to a method of detecting MCG18 with an antibody directed against the protein (SEQ ID NO: 9).

The inventions listed as Groups I-XII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the special technical feature of each group is the structural, functional characteristics of the specific nucleic acid or polypeptide featured in that group. For example, the special technical feature for each of Groups I-IV is based upon the particular nucleic acid sequence that encodes a specified regulator of gene expression. The special technical feature of each of Groups V, VII, IX and XI is based upon the particular amino acid sequence for a specified regulator of gene expression that is to be detected. The special technical feature for each of Groups VI, VIII, X and XII is based upon an antibody that specifically recognizes a given regulator of gene expression.

A telephone call was made to Frank Digiglio on 1-8-02 to request an oral election to the above restriction requirement, but did not result in an election being made.

Art Unit: 1636

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald G Leffers Jr. whose telephone number is (703) 308-6232. The examiner can normally be reached on 9:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel can be reached on (703) 305-1998. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7939 for regular communications and (703) 305-7939 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Gerald G Leffers Jr.
Examiner
Art Unit 1636

ggl

ggl

January 8, 2002

DAVID GUZO
PRIMARY EXAMINER
David Guzo